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JJG: 08-02

Paper No: 19

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OFFICE OF PETITIONS

In re Application of:
Nichol
Filed: 30 June, 1998
Application No. 09/106,841
Attorney Docket No. (None)

DECISION ON PETITION

This is a decision on the petition filed herein on 14 May, 2002, under 37 C.F.R. §1.137(b)¹ to revive the above-identified application.

For the reasons set forth below, the petition is **DISMISSED**.

NOTES: (1) Your petition (and fee) for reconsideration of this decision **must** be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)." (2) There will be no further reconsideration thereafter.

BACKGROUND

The record indicates that:

- Petitioner failed to respond timely and properly to a final Office action mailed on 3 January, 2001, and due (absent extension of time) on or before 3 July, 2001;

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). A grantable petition filed under the provisions of 37 C.F.R. §1.137(b) **must** be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
(2) the petition fee as set forth in 37 C.F.R. §1.17(m);
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

- the instant application went abandoned after midnight 3 July, 2001;
- Notice of Abandonment was mailed on 17 July, 2001;
- Petitioner's 26 September, 2001, request for withdrawal of the holding of abandonment was dismissed on 15 March, 2001;
- Petitioner filed the instant petition (and fee), statement of unintentional delay and an amendment, which amendment is not a proper response to a final office action.²

STATUTES AND REGULATIONS

Congress has authorized the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent."³ 35 U.S.C. §41(a)(7) (1994).

The language of 35 U.S.C. §41(a)(7) and 37 C.F.R. §1.137(b) is clear and unambiguous: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unintentional--without qualification--for the reply now to be accepted on petition.

Moreover, Petitioner must satisfy the reply requirement with a proper reply in the form of a request for continued examination (RCE) (with fee) and required submission under 37 C.F.R. §1.114.⁴

² The proper response to the final Office action (see: Fn. 1, item (1); MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a request for continued examination (RCE) under 37 C.F.R. §1.114 or a continuing application.

³ As amended 1 December, 1997, 37 C.F.R. §1.137(b)(3) provides that a petition under 37 C.F.R. §1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional."

⁴ The regulations at 37 C.F.R. §1.114 provide:

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

CONCLUSION

The instant petition fails to satisfy the "reply" requirement as to relief sought. In the absence of that requirement, the petition herein must be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
 2201 South Clark Place
 Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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